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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/840,288 | 04/23/2001 | Todd M. Baranek | P01031US1A | 3323 |

7590 05/23/2002
Chief Intellectual Property Counsel
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| EXAMINER |
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MICHL, PAUL R

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| ART UNIT | PAPER NUMBER |
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1714

DATE MAILED: 05/23/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☐ Responsive to communication(s) filed on _____
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-20 is/are pending in the application.
- ☐ Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-20 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-20 are rejected under 35 U.S.C. § 102(b) as being anticipated by Okubo or Kalinowski or Lorraine or Hayashi or Morgan. Applicants' claims are directed to a composition comprising elastomer and high density metal oxide. Okubo, Kalinowski, Lorraine, Hayashi, and Morgan all disclose compositions comprising elastomer and high density metal oxide. Applicants' claims lack novelty. See claim 2 of Okubo. See column 22, lines 30-67 of Kalinowski. See claim 18 of Lorraine. See the Abstract of Hayashi. See claim 11 of Morgan.

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Claims 1-20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Okubo or Kalinowski or Lorraine or Hayashi or Morgan. . It would be obvious to one of ordinary skill in the art to formulate compositions according to these references comprising elastomer and a high density metal oxide. The motivation is that it is within the skill of one in the art to select a suitable metal oxide density for use as the metal oxide within the context of these references.

Claims 1-20 are rejected under 35 U.S.C. § 112 second paragraph for failure to particularly point out and distinctly claim what applicants consider to be the invention and for being indefinite. Applicants recite the phrase "metal oxide". However, applicants recite "phosphorus oxides" in claim 4. Phosphorus is not a metal. Therefore phosphorus oxides are not metal oxides and are not within the scope of claims 1, 2, 3, or 5-20. Claim 4 is indefinite because it improperly depends upon claim 1. The phrase "metal oxide" fails to particularly point out and distinctly claim what applicants consider the invention to be because applicants do not consider metal oxides to be the invention as evidenced by the recitation of phosphorus oxides in claim 4.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Michl whose telephone number is (703) 308-2451. The examiner can

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normally be reached on Monday through Friday from 7:30 A.M. to 4 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (703) 306-2777. The fax phone number for this Group is (703) 305-5433.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-2351.

PRMichl:cdc

May 17, 2002


PAUL R. MICHL
PATENT EXAMINER
ART UNIT 156